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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,719	03/09/2004	Mark G. Currie	14184-043001	1787

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FISH & RICHARDSON PC  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER
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TELLER, ROY R

ART UNIT	PAPER NUMBER
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1654

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/796,719

Applicant(s)

CURRIE ET AL.

Examiner

Roy Teller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5,8-13 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,8-13,20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This office action is in response to the amendment, received 1/12/07, in which applicant amended claim 1. This follows the response to the election, received 10/26/06, in which applicant elected group I, claims 1-20, 25, 35-38. Applicant further elected SEQ ID NO: 31, which read on claims 1, 5, 8-13 and 20. Claims 2-4, 6-7, 14-19, and 21-79 were cancelled. Claim 20 was deemed drawn to allowable subject matter in the previous office action, but in light of prior art, claim 20 is under examination again.

Claims 1, 5, 8-13 and 20 are under examination.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5, 8-13 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending

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Application No.10/899,806. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention is drawn to a purified peptide comprising the amino acid sequence Xaa1-Xaa2-Xaa3-Xaa4-Xaa5-Cys6-Cys7-Xaa8-Xaa9-Cys10-Cys11-Xaa12-Xaa13-Xaa14-Cys15-Xaa16-Xaa17-Cys18-Xaa19-Xaa20-Xaa21 wherein Xaa1, Xaa2, Xaa3, Xaa4, Xaa5 is missing, Xaa9 is Phe, Trp or Tyr, and Xaa8, Xaa12-Xaa14, Xaa16-Xaa17, Xaa19-Xaa21 are any of the 20 naturally occurring amino acids. A purified peptide consisting of the amino acid sequence: Cys-Cys-Glu-Tyr-Cys-Cys-Asn-Pro-Ala-Cys-Thr-Gly-Cys-Tyr (SEQ ID NO:31), a 14 mer residue is recited.

The '806 application is drawn to a 14 mer residue, SEQ ID NO: 3, that is a match to instant SEQ ID NO: 31. See, i.e, for example, claims 1-3. This reads on the limitations of instant claims 1, 5, 8-13 and 20.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 5, 8-13 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18, 20 and 24 of copending Application No.10/845,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention is drawn to a purified peptide comprising the amino acid sequence Xaa1-Xaa2-Xaa3-Xaa4-Xaa5-Cys6-Cys7-Xaa8-Xaa9-Cys10-Cys11-Xaa12-Xaa13-Xaa14-Cys15-Xaa16-Xaa17-Cys18-Xaa19-Xaa20-Xaa21 wherein Xaa1, Xaa2, Xaa3, Xaa4, Xaa5 is missing, Xaa9 is Phe, Trp or Tyr, and Xaa8, Xaa12-Xaa14, Xaa16-Xaa17, Xaa19-Xaa21 are any of the 20

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naturally occurring amino acids. A purified peptide consisting of the amino acid sequence: Cys-Cys-Glu-Tyr-Cys-Cys-Asn-Pro-Ala-Cys-Thr-Gly-Cys-Tyr (SEQ ID NO:31), a 14 mer residue is recited.

The '895 application is drawn to a 14 mer residue, SEQ ID NO: 3, that is a match to instant SEQ ID NO: 31. See, i.e., for example, claims 18, 20 and 24. This reads on the limitations of instant claims 1, 5, 8-13 and 20.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 5, 8-13 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 19 and 23 of copending Application No.10/766,735. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention is drawn to a purified peptide comprising the amino acid sequence Xaa1-Xaa2-Xaa3-Xaa4-Xaa5-Cys6-Cys7-Xaa8-Xaa9-Cys10-Cys11-Xaa12-Xaa13-Xaa14-Cys15-Xaa16-Xaa17-Cys18-Xaa19-Xaa20-Xaa21 wherein Xaa1, Xaa2, Xaa3, Xaa4, Xaa5 is missing, Xaa9 is Phe, Trp or Tyr, and Xaa8, Xaa12-Xaa14, Xaa16-Xaa17, Xaa19-Xaa21 are any of the 20 naturally occurring amino acids. A purified peptide consisting of the amino acid sequence: Cys-Cys-Glu-Tyr-Cys-Cys-Asn-Pro-Ala-Cys-Thr-Gly-Cys-Tyr (SEQ ID NO:31), a 14 mer residue is recited.

The '735 application is drawn to a 14 mer residue, SEQ ID NO: 31, that is a match to instant SEQ ID NO: 31. See, i.e., for example, claims 1, 19 and 23. This reads on the limitations of instant claims 1, 5, 8-13 and 20.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Drmanac et al. (WO 01/75067).

The instant invention is drawn to a purified peptide comprising the amino acid sequence Xaa1-Xaa2-Xaa3-Xaa4-Xaa5-Cys6-Cys7-Xaa8-Xaa9-Cys10-Cys11-Xaa12-Xaa13-Xaa14-Cys15-Xaa16-Xaa17-Cys18-Xaa19-Xaa20-Xaa21 wherein Xaa1, Xaa2, Xaa3, Xaa4, Xaa5 is missing, Xaa9 is Phe (F), Trp (W) or Tyr (Y), and Xaa8, Xaa12-Xaa14, Xaa16-Xaa17, Xaa19-Xaa21 are any of the 20 naturally occurring amino acids. Therefore, by applicant's definition, the instant polypeptide could be as follows: a 16 amino acid polypeptide of the following sequence- C-C-C-Y-C-C-C-C-C-C-C-C-C-C-C-C. C.

Drmanac et al. discloses novel polypeptide sequences. The polypeptide sequences are designated SEQ ID NO : 30,369- 60,736. See, i.e, for example, abstract and page 2, lines 6-7. SEQ ID NO: 49,367 is a 398 amino acid polypeptide whose residues #193-208 (C-C-C-Y-C-C-C-C-C-C-C-C-C-C-C-C) read on the limitations of instant claim 1. SEQ

Therefore, the cited reference is deemed to anticipate the instant claim above.

## Conclusion

**All claims are rejected.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy Teller whose telephone number is 571-272-0971.

The examiner can normally be reached on Monday-Friday from 5:30 am to 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ANISH GUPTA  
PRIMARY EXAMINER